

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IRMGARD ROST

Appeal No. 2002-2128
Application No. 08/793,984

HEARD: December 12, 2002

Before RUGGIERO, BARRY, and SAADAT, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 43-51 and 53-84, which are all of the claims pending in the present application. Claims 1-42 and 52 have been canceled.¹ An amendment filed April 27, 2001 after final rejection, which amended claim 84, was approved for entry by the Examiner.

¹ Both Appellant and Examiner should take note of the fact that claims 53-56 are presently dependent upon claim 52 which has been canceled.

The disclosed invention relates to a personal data archive system for transporting large quantities of data, such as medical history data, from one application to another or from one service provider to another. Included in the system are first and second portable memory devices and at least one associated authorization checking device. The first portable memory device, which stores non-critical but frequently used data, is accessible independent of the second portable memory device, which has a larger data storage capacity and is used to store critical but less frequently used data.

Claim 43 is illustrative of the invention and reads as follows:

43. A personal data archive system comprising:

a first portable memory device containing personal data solely of a single owner;

a second portable memory device of greater data storage capacity than and differing from said first portable memory device, said second portable memory device containing additional personal data associated solely with said single owner, wherein said second portable memory device is separate from said first portable memory device, and a full set of personal data consists of data of the single owner stored on said first and second portable memory devices; and at least one authorization-checking device associated with said first and second portable memory devices in order to access data stored on each memory device wherein the authorization-checking device can be enabled only as a function of a positive authorization and authentication process; and

wherein the first portable memory device is accessible independent of the second memory device, and the full set of unique, personal data belonging to a single owner is accessible only when the first portable memory device is used in combination with the second portable memory device and only after a positive authorization and authentication process is performed through said authorization checking device.

The Examiner relies on the following prior art reference:

Watanabe	4,709,136	Nov. 24, 1987
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Claims 43-51 and 53-84 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's

² The Appeal Brief was filed August 9, 2001 (Paper No. 20). In response to the Examiner's Answer dated October 23, 2001 (Paper No. 21), a Reply Brief was filed December 26, 2001 (Paper No. 22), which was acknowledged and entered by the Examiner as indicated in the communication dated February 12, 2002 (Paper No. 23).

rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 43-51 and 53-84. Accordingly, we reverse.

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 43 and 84 based on Watanabe, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the limitations of claims 43 and 84 are not taught or suggested by the applied Watanabe reference. In particular, Appellant contends (Brief, page 8; Reply Brief, pages 5 and 6) that Watanabe does not provide for the accessibility of a first memory device independent from a second memory device, a feature present in each of the independent claims 43 and 84.

After careful review of the Watanabe reference, in light of the arguments of record, we are in general agreement with Appellant's position as stated in the Briefs. Although the Examiner (Answer, page 7) points to the background discussion at column 1, lines 58-67 of Watanabe, which makes reference to existing personal data archive systems with independently

accessible memory cards, the bulk of the disclosure of Watanabe is directed to solving security problems attendant to systems with independently accessible memory cards. It is apparent from a reading of Watanabe that Watanabe's solution to the access security problem, in direct contrast to Appellant's claimed independent access feature, is to require that a first memory card can not be accessed without the presence and authorization of a second memory card. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. V. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 311 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984). Given the deficiencies in the disclosure of Watanabe, it is our view that any suggestion to modify Watanabe to arrive at Appellant's claimed invention could not come from any teaching in Watanabe but, rather, only from Appellant's own disclosure.

We are further of the view that even assuming, arguendo, the existence of personal data archive systems with memory devices having independent accessibility, there is no indication from the Examiner as to how and in what manner the Watanabe reference would be modified to arrive at the particulars of Appellant's invention as set forth in independent claims 43 and 84. In order for us to

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sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968).

In view of the above discussion, it is our view that, since all of the limitations of the appealed claims are not taught or suggested by the applied prior art Watanabe reference, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C. § 103(a) rejection of independent claim 43 and its dependent claims 44-51 and 53-83, as well as independent claim 84, is not sustained.

In conclusion, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 43-51 and 53-84 is reversed.

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REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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